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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,630	04/06/2001	Eric J. Sprunk	18926003160	9042

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GENERAL INSTRUMENT CORPORATION
101 Tournament Drive
Horsham, PA 19044

EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/827,630	Applicant(s) SPRUNK, ERIC J.	
	Examiner Ponnoreay Pich	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/2006 has been entered.

Claims 1-7 and 11-14 are pending.

Oath/Declaration

Applicant electronically submitted a new oath on 10/19/2006. There are entire sections of the oath the examiner is unable to read since the text scanned in by applicant's fax machine is so light. The examiner respectfully requests that applicant file a more legible copy so that the examiner may determine if the oath is in proper format and if proper priority has been claimed. The oath is objected to until such time that the examiner is presented with a copy that is legible and in proper format.

Response to Arguments

The declaration filed on under 37 CFR 1.131 has been considered but is ineffective to overcome the Epstein reference. As a preliminary matter, note that provisional application 60/158,491 was filed on 10/8/1999, not 11/12/1999 as stated on page 3, item 7 of the declaration submitted by applicant on 10/19/2006. Applicant is

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respectfully advised to double check the dates on the applications and what is stated in the declaration and remarks.

The declaration submitted is ineffective to overcome Epstein because the evidence submitted with the declaration is insufficient to establish diligence from a date prior to the date of reduction to practice of the Epstein reference to either a constructive reduction to practice or an actual reduction to practice. On page 3, point 7 of declaration filed on 10/19/2006, applicant states that applicant exercised diligence from prior to July 14, 1998 until the filing of the current application and the provisional applications from which the current application is claiming priority. However, a showing of facts is necessary to establish diligence (see 37 CFR 1.131(b)). Applicant has not provided any fact or evidence which supports applicant's declaration of diligence by the part of applicant in the development and testing of the invention nor any evidence of diligence by applicant and the legal department of applicant's company in the filing of the current application. A statement that diligence was exercised is not fact nor is it evidence, thus by itself is insufficient to establish the necessary diligence as required by 37 CFR 1.131.

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country prior to or after the effective date of the Epstein reference. Though the Invention Record Form indicates that the invention was built and tested by what appears to the examiner to be September 1999, the declaration and evidence failed to establish that the actual reduction to practice occurred in this country or a NAFTA or

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WTO member country. In fact, there is not any mention of the country in which the actual reduction to practice occurred. Further, the inventor record form indicating that a working model was built and tested is not proper evidence that actual reduction to practice occurred. This record form does not have any test data showing that the model that was built works.

The declaration is also insufficient to overcome the Epstein reference because applicant still failed to clearly explain which facts or data applicant is relying on to show completion of his invention prior to the date of the Epstein reference (see MPEP 715.07). Applicant states in item 2 of the declaration that claims 1-7 and 11-14 were described in an "Invention Record Form" on 10/5/1999. Item 3 states that claims 1-7 and 11-14 were conceived prior to the date of the Epstein reference as evidenced by the "Application Security for TCI" document. However, applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. With the "Invention Record Form", the examiner has a difficult time understanding what the inventor has written due to the inventor's handwriting, so applicant should clearly explain the evidence presented and map how the evidence presented shows that applicant had priority over the limitations claimed (see MPEP 715.07). The memorandum submitted is also difficult to read. The examiner respectfully requests that a clearer copy be submitted if one is available and advises applicant to clearly map which parts of the memorandum shows conception of what claimed limitations as well as explain what the inventor has written in the Inventor

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Record Form since the inventor's handwriting makes reading and understanding the form difficult.

For the at least the reasons given above, the declaration is insufficient to overcome the prior art of record. If applicant wishes to submit another 1.131 declaration, the above defects as well as any other the examiner may have inadvertently missed must be corrected and proper evidence provided along with the declaration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Epstein (US 6,865,675).

Claim 1:

Epstein discloses:

1. Receiving a secure portion of a secure object (Fig 4 and col 6, lines 47-58).
2. Receiving a plaintext remainder of the secure object (Fig 4 and col 6, lines 47-58).

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3. Determining which portion of the secure object is the secure portion (Fig 4 and col 6, lines 58-61).
4. Decrypting the secure portion to provide a plaintext portion (Fig 4 and col 6, lines 58-61).

Epstein further inherently discloses forming the plaintext object that comprises the plaintext portion and the plaintext remainder and storing the plaintext object (Fig 4). Note that on page 6 of applicant's specification, an object is defined as "any collection of digital information." The examiner submits that the decrypted ticket along with the content data disclosed by Epstein comprises the plaintext object, as together they are a collection of digital information and they are both in non-encrypted format. Further, a valid ticket is needed to enable access to the content data, so the ticket must always be located with the digital content (Fig 4). The examiner further submits that to display the content using the display device, the plaintext content must also be stored by the display device to some degree.

Claim 2:

Epstein further discloses:

1. Selecting a secure portion of the plaintext object to encrypt (Fig 4 and col 12, lines 21-26).
2. Encrypting the secure portion (Fig 4 and col 12, lines 21-26).
3. Sending the secure portion and the plaintext remainder to a set to box (Fig 4 and lines 24-26).

4. Providing a key that is used in decryption of the secure portion (Fig 4 and col 12, lines 4-7 and 26-30).

Claim 3:

Epstein inherently discloses reporting purchase of the plaintext object a point away from the set top box (col 9, lines 16-21). Epstein discloses that the sink device makes a request to the source device to begin transmission of the protected content to the sink device (col 9, lines 16-21). The examiner submits that this reads on the limitation recited in claim 3 as the source device is a point away from the set top box and the set top box must provide proof of purchase or make a purchase at the source device before the source device would transmit the plaintext object. One of ordinary skill should appreciate that if the source device transmits the plaintext object (which includes a valid ticket) without first receiving proof of purchase, then there would be no point to the conditional access system disclosed by Epstein for controlling access to protected content.

Claim 5:

Epstein inherently discloses wherein the decrypting step comprises a step of decrypting the secure portion with an access control processor (col 9, lines 55-65).

Claim 7:

Claim 7 is substantially similar to claim 2 and is rejected for the same reasons. The difference between the two claims lies in the preamble. Claim 2 recites a set top box, while claim 7 recites a conditional access system. However, the examiner submits that a set top box is inherently part of a conditional access system.

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Claim 11:

Epstein inherently discloses wherein removal of the secure portion from the plaintext object renders the plaintext object inoperable (Fig 4). The secure portion, i.e. encrypted ticket, is needed to enable access to the digital content (Fig 4). It is inherent that if the ticket was removed from the plaintext object that the plaintext object would be rendered inoperable.

Claim 12:

Epstein further discloses a step of changing authorization of the set top box from a point remote to the content receiver (Fig 4). Note the conditional access device sends the ticket which authorizes the set top box to access the content. The conditional access device is at a point remote from the receiver.

Claim 13:

The limitation recited in claim 13 is substantially similar to the one rejected in claim 3 and is rejected for the same reasons. The difference is that claim 3 recites reporting the purchase while claim 13 recites receiving the purchase information. Both language essentially amounts to the same thing, however, as the purchase information cannot be received unless it was reported.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein (US 6,865,675).

Claim 6:

Epstein does not explicitly disclose the secure portion is less than one-half the size of the secure object. However, the secure portion is the encrypted ticket, which once decrypted is hashed to determine if it matches the watermark of the digital content (Fig 4). The ticket itself was originally derived from the watermark via a hash function (col 3, lines 26-27). The digital content can comprise any type of digital content including MPEG data (col 8, lines 29-44). One of ordinary skill should appreciate that traditionally a watermark is substantially smaller than the content it is encoded in, so this means that the watermark is less than one-half the size of the digital content. As the ticket is derived from the watermark, it should be obvious to one of ordinary skill that the secure portion (i.e. encrypt ticket) is less than one-half the size of the secure object, which comprises the encrypted ticket and the watermarked digital content.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein (US 6,865,675) in view of Wasilewski et al (US 6,157,719).

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Claim 4:

Epstein does not explicitly disclose wherein the second listed receiving step is performed before the reporting step. However, Wasilewski discloses that at the time the applicant's invention was made, it was common to permit access to broadcast information only to those who paid for it, which was usually done via scrambling the content (col 1, line 65-col 2, line 5).

It is obvious from Wasilewski's teachings that it is common practice for the content to be continuously transmitted to the set top box, but only once the content is purchased and the purchase was reported would the set top box be allowed access to the content. In the case of Epstein's invention, one of ordinary skill should appreciate that enablement of the content data would be through the receipt of a valid ticket at the set top box. Thus, the second listed receiving step would have commonly been performed before the reporting step. One of ordinary skill would have been motivated to incorporate Wasilewski's teachings because he teaches that what he disclosed was one of the common alternatives to making money by distributing information on a broadcast medium (col 1, lines 61-63).

Note that it would have been just as obvious to send the plaintext remainder before after the purchase was reported. The choice of when to do the sending is arbitrary as the receiver cannot use the content until a valid ticket is sent and a valid ticket would not be sent until a purchase is reported. Either choice would not differentiate from the spirit of Epstein's invention.

Claim 14:

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Epstein does not disclose the key is a symmetric key. However, Wasilewski discloses a key being a symmetric key (col 6, lines 18-23). It would have been obvious to one of ordinary skill in the art at the time the application's invention was made to have incorporated Wasilewski's teachings with Epstein so that the key is a symmetric key. One of ordinary skill would have been motivated to incorporate Wasilewski's teachings as he discloses that his teachings would permit an easy way of permitting a customer to change entitlement agents as he or she sees fit (col 10, lines 50-51).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

Ponnoreay Pich
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